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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,040	06/15/1999	KENLEY H. WONG	081862.P151	4869

7590 07/21/2003

BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BLVD  
7TH FLOOR  
LOS ANGELES, CA 900251026

EXAMINER

DO, NHAT Q

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/334,040

Applicant(s)

WONG ET AL.

Examiner

Nhat Do

ND

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7 is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 9 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Allowable Subject Matter*

1. Claims 4-7 are allowed
2. Claims 2, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
3. The indicated allowability of claims 1, 3, and 9 are withdrawn in view of the newly discovered reference(s) to Europe Patent Application No. DE 03917482 filed by Eilts et al, and U.S. Patent. No. 6,553,117 to Armistead et al. Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "watching" in line 4 should be changed to (for example) "detecting" because a skilled artisan is familiar with measuring or detecting a voltage change but watching a voltage change is a new technique, therefore, it must be disclosed in detail in the specification.

7. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the protocol" in line 6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Europe Patent

Application No. DE 03917482 filed by Eilts et al.

Eilts et al disclose a system in the abstract comprising:

Internal controllers (devices) connected to each other via a redundancy line;

Detecting the status (mode) of the working controller by measuring voltage change at the contact;

Switch on in response to the measured voltage change.

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent. No. 6,553,117 to Armistead et al.

Armistead et al disclose a system with an interface module in figure 4 comprising:

A processor 36;

A framer F0 controlled by the processor 36 (Col. 4, lines 43-53);

Since the processor execute software to control the framer F0 to process data as either T1 or E1 format, and it is well known that the software, which is stored in memory, is a set of specific instructions to direct the processor to perform desired functions, it is inherent that there is a memory coupled to processor for storing set of rules for instructing the framer F0.

Armistead et al fail to disclose the interface module detects a protocol for which the system should be configured, but only suggest that the system may be capable of detecting which protocol is being used (See from col. 2, line 32). For the processor activates proper commands to control the interface F0, acknowledge about the protocol used by the received data must be obtained. Therefore, A skilled artisan would have been motivated to design the interface module so that it can detect the protocol of the received data as suggested by Armistead et al and notify the processor the detected protocol. Therefore, it would have been obvious to a person having

ordinary skill in the art by the time the invention was made to modify the interface so that it detects which protocol the system should be configured.

Regarding to claim 3, the module in figure 4 is considered the claimed second device.

Armistead et al also disclose in figure 3 that the module 22 is connected to the cable 20, and it is inherent that the cable 20 is also connect to a first device at the other end.

Armistead et al fail to disclose the cable has an RJ-48 connector at one end and a BNC connector at the other end.

However, Armistead et al disclose the system can support all 75, 100 and 120 Ohms standards (Col. 4, lines 53-65). Since it is well known that 75 Ohms standard implies E1 unbalanced standard, which uses BNC coaxial connector, 100 and 120 Ohms standards imply T1 and E1 balanced standard, which uses RJ 48 connector. A skilled artisan would have been motivated to use appropriate connector at two ends of the cable (all BNC, RJ 48 or BNC at one end and RJ 48 at the other end) depending on the standard used by the system at that end. Therefore, it would have been obvious to a person having ordinary skill in the art by the time the invention was made to make the cable has an RJ-48 connector at one end and a BNC connector at the other end.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhat Do whose telephone number is (703) 305-5743. The examiner can normally be reached on 8:30 AM - 5:30 PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-6743 for regular communications and 703-308-6743 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nhat Do  
Examiner  
Art Unit 2663

ND

July 14, 2003

  
MELVIN MARCELO  
PRIMARY EXAMINER